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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,899	02/06/2004	David J. Steele	2002-IP-008437 U1 USA	8337
20558	7590	11/10/2005	EXAMINER	
KONNEKER & SMITH P. C. 660 NORTH CENTRAL EXPRESSWAY SUITE 230 PLANO, TX 75074			THOMPSON, KENNETH L	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/773,899	Applicant(s) STEELE ET AL.	
	Examiner Kenneth Thompson	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-137 is/are pending in the application.
4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-15, 38-43, 50-52, 54, 55, 60-69, 72-74, 82, 86, 93, 96-99, 103-119, 121, 122 and 126 is/are rejected.
- 7) ☒ Claim(s) 7-10, 16-34, 36, 37, 44-49, 53, 70, 71, 75-80, 85, 94 and 95 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/6/05; 6.5.3/04</u> . | 6) <input type="checkbox"/> Other: ____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 35,56-59,81,83,84,87-92,100-102,120,123-125 and 127-137.

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species I - Figures 1-7
- Species II - Figure 8
- Species III - Figures 9 and 10
- Species IV - Figure 11.

During a telephone conversation with Marlin R. Smith on 13 September 2005 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-34, 36-55, 60-80, 82, 85, 86, 93-99, 103-119, 121, 122 and 126. Affirmation of this election must be made by applicant in replying to this Office action. Claims 35, 56-59, 81, 83, 84, 87-92, 100-102, 120, 123-125 and 127-137 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3672

Claims 1-6, 11-15, 38-43, 50-52, 54, 55, 60, 96, 99 and 103 are rejected under 35 U.S.C. 102(b) as being anticipated by Leighton, U.S. 5,964,288.

Regarding claims 1-6, 11-15, 38-43, 50-52, 54, 55, 60, 96, 99 and 103, Leighton discloses an expandable chamber (1) having moveable, multiple, bonded (3) inflatable layers (flattened walls forming branches 11, 10) having exits (fig 11, outlet from "Y" branches and trunk), inner shell and (7) outer shell (8); a tubing string connection (2, 20); hardening (col. 1, lines 45-50) the load bearing or cement material (8) and inflating the layers within an enlarged chamber (6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-69, 72-74, 82, 86, 93, 97, 98, 104-119, 121, 122 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton, U.S. 5,964,288.

As to claims 61-69, 72-74, 82, 86, 93, 97, 98, 104-119, 121, 122 and 126, Leighton discloses the load bearing material. Leighton does not disclose all the claimed material included therein. However it has been held that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Allowable Subject Matter

Claims 7-10, 16-34, 36, 37, 44-49, 53, 70, 71, 75-80, 85, 94 and 95 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including load bearing material between the inner and outer shells.

The prior art of record does not disclose or suggest all the claimed subject matter including cementing the chamber.

The prior art of record does not disclose or suggest all the claimed subject matter including positioning the material uphole, while expanding nor during expansion.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Surjaatmadja et al., U.S. 6,401,815 discloses a similar inflatable chamber.


Endoh, U.S. 5,329,063 and Mandich, U.S. 5,395,472 discloses a similar inflatable multi-wall chamber.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Thompson whose telephone number is 571 272-7037. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

02 November 2005



Kenneth Thompson
Primary Examiner
Art Unit 3672